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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/732,871	12/09/2003	James S. Voss	200314332-1	6843

22879 7590 10/19/2006

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EXAMINER	
WHIPKEY, JASON T	

ART UNIT	PAPER NUMBER
2622	

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/732,871	**Applicant(s)** VOSS ET AL.
	Examiner Jason T. Whipkey	**Art Unit** 2622

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 September 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
   b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *1-19*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attachment.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____
13. ☐ Other: _____.

DETAILED ACTION

1. Applicant's arguments filed September 26, 2006, have been fully considered but they are not persuasive.

On page 4, Applicant argues that:

> [T]he Examiner's issuance of a final office Action is unwarranted and improper. ... It appears that the Examiner has searched the Japanese patent office records to find the [Watanabe] reference. This could have been done as part of the original search by the Examiner. Applicant should not be penalized because the Examiner uncovered new art that should have been uncovered in the initial search.

This argument is spurious. Since Applicant made a substantive amendment to the independent claims, the designation of the previous Office action as final is proper. The second action on the merits of a case is, by default, final, with limited exceptions. See MPEP § 706.07(a).

The Watanabe reference was as accessible to Applicant as it was to the examiner. It is Applicant's responsibility not to merely amend the claims to overcome the prior art of record but to write original claims that overcome all prior art. Applicant's failure to do so will not result in the Office entertaining claim amendments *ad infinitum* during a single examination. Additionally, the examiner cannot anticipate and provide art for every possible amendment that Applicant may choose to make in the future.

On page 5, paragraph 1, through page 6, paragraph 5, Applicant argues regarding claims 1-4, 7-12, and 15-17 that paragraphs 38-40 of the Watanabe reference do not perform the claimed firmware processing. However, Applicant is not considering the reference in its entirety. Paragraphs 38-40 disclose that Watanabe's camera has, as claimed, instructions that run

on "processing circuitry that processes geographic location and time data entered into the camera to automatically select one of the profiles". The examiner noted in the rejection of claim 1 that paragraph 47 of Watanabe discloses profiles — namely, "gain value Rg and the gain value Bg which were beforehand defined according to the weather". These initial gain values (i.e., profiles) are selected based on the weather, which is retrieved using the current time and position (see paragraph 46).

On page 7, paragraph 1, regarding claims 6, 14, and 19, Applicant argues that "the Watanabe reference teaches away from manually entering location data and thus the teachings of the Aoki patent would not be combined therewith by one skilled in the art." However, Applicant's only evidence that Watanabe "teaches away" from manual entry is that Watanabe discloses automatic entry of data.

This assertion belies the intent of 35 U.S.C. 103(a), which prevents the issuance of a patent despite "differences between the subject matter sought to be patented and the prior art". In other words, all § 103 rejections will be based on at least one feature that the primary reference (in the instant case, Watanabe) does not disclose. The mere fact that a reference performs a task in a particular manner does not mean that said reference "teaches away" from performing the task in another manner.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Whipkey, whose telephone number is (571) 272-7321. The examiner can normally be reached Monday through Friday from 9:00 A.M. to 5:30 P.M. eastern daylight time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vivek Srivastava, can be reached at (571) 272-7304. The fax phone number for the organization where this application is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JTW
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October 11, 2006

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